

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
Application Serial No.: 09/580,904
Attorney Docket No.: 042846-0312808



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Avner SHAFRIR, *et al.*
SERIAL NUMBER: 09/580,904 EXAMINER: Tadesse Hailu
FILING DATE: May 31, 2000 ART UNIT: 2173
FOR: VISUAL INDICATOR OF NETWORK USER STATUS BASED ON USER
INDICATOR

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on December 2, 2005 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed January 30, 2006, Appellants respectfully submit an Appeal Brief pursuant to 37 C.F.R. § 41.37.

The Director is authorized to charge the \$500.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (Ref. No. 042846-0312808).

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REQUIREMENTS OF 37 C.F.R. §41.37

I. 37 C.F.R. § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation.

II. 37 C.F.R. § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

U.S. Patent Application Serial No. 09/583,734 (hereinafter “the ‘734 Application”), entitled “COLLABORATIVE APPLICATION WITH INDICATOR OF CONCURRENT USERS,” and filed May 31, 2000, is currently on Appeal before the Board of Patent Appeals and Interferences. An Appeal Brief in the ‘734 Application was filed February 1, 2006.

U.S. Patent Application Serial No. 09/583,736 (hereinafter “the ‘736 Application”), entitled “COMMUNICATIONS LINK SYSTEM BASED ON USER INDICATOR,” and filed May 31, 2000, is currently on Appeal before the Board of Patent Appeals and Interferences. An Appeal Brief in the ‘736 Application was filed February 2, 2006.

III. 37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Pending: Claims 1-33 are pending.

Cancelled: No claims are cancelled.

Rejected: Claims 1-33 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejection of claims 1-33 under

35 U.S.C. § 103(a) is appealed.

IV. 37 C.F.R. § 41.37(c)(1)(iv) – STATUS OF AMENDMENTS

No Amendments have been filed subsequent to Final Rejection.

V. 37 C.F.R. § 41.37(c)(1)(v) – SUMMARY OF CLAIMED SUBJECT MATTER

Various instant messaging type applications now exist. One feature of some of these applications is that they can provide an indication of the status of network users (e.g., whether they are detected to be online). However, this user status feature is typically specific to that instant messaging application and enables communication with a user via the instant messaging application.

According to one aspect of the invention, a user indicator can be presented within two or more *types* of electronic documents using two or more *types* of applications. (Specification at page 7, lines 11-19).

One advantage of this aspect of the invention is that it extends the user indicator feature across multiple applications and multiple document types. According to one embodiment, the system may include a user indicator presentation means for enabling presentation of at least one user indicator within *two or more types of electronic documents*. The electronic document types are recited as being capable of being generated using the *two or more types of applications*. (Specification at page 5, lines 21-31). The user indicator(s) is (are) associated with the one or more target network users. A status presenting means for presenting status indicators associated with corresponding user indicators provide *the real-time status* of the one or more target network users. (Specification at page 9, lines 19-30). A communication means is provided for enabling the first network user to initiate communications with at least one of the target network users by selecting the desired user indicator. (Specification at page 1, lines 28-30).

For example, the invention may include *two or more user indicators* presented in two or more types of documents generated by two or more types of applications, including

at least *two user depictions* associated with at least two target network users. (Specification at page 17, lines 1-20). An identification determining module may reference a user directory to access at least two user indicators that correspond to the at least two target network users. (Specification at page 10, lines 28-32). The presentation module is capable of presenting the at least two user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications. A status determining module may determine real-time status of the at least two target network users including an availability of the at least two target network users to engage in a communication. (Specification at page 9, lines 12-32). A communication module can establish a communication link with one or more of the at least two target network users based on the determined availability of the at least two target network users. (Specification at page 14, lines 5-32). One advantage of this aspect of the invention is that it enables display to a first user of a list of target network users and their status.

VI. 37 C.F.R. § 41.37(c)(1)(vi) – GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (35 U.S.C. § 103).

Claims 1-33 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Mirabilis Ltd., Quick Tour (“Quick Tour”), allegedly disclosed February 12, 1998, in view of ICQ Inc., ICQ Email Signature (“ICQ Email Signature”), allegedly disclosed May 2, 1999.

VII. 37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

A. The rejection of claims 1-33 under 35 U.S.C. § 103 fails to establish a *prima facie* case of obviousness

The rejection of Claims 1-33 under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis LTD, Quick Tour (“Quick Tour”), allegedly disclosed February 12, 1998, in

view of ICQ Inc., ICQ Email Signature ("Email Signature")¹, allegedly disclosed May 2, 1999 is legally improper for at least the following reasons.

Independent claim 1 recites, among other things, "user indicator presentation means for enabling presentation of one or more user indicators within the *two or more types of electronic documents*, wherein the electronic document types are capable of being *generated using two or more types of applications* and wherein each user indicator is associated with at least one target network user" (claim 1, emphasis added). Neither Quick Tour nor Email Signature, whether considered alone or in combination, disclose at least these features.

The Examiner acknowledges that Quick Tour fails to disclose these features. Final Office Action, p. 4-5. The Examiner erroneously relies on Email Signature to overcome these admitted deficiencies. However, the Examiner has failed to establish that Email Signature discloses these features admittedly missing from the primary reference.

One of the legal errors committed by the Examiner is the failure to properly consider the specific claim language referred to above. The Examiner relies on Email Signature for allegedly enabling a user to include a signature block including a user's ICQ address in an email message, and allegedly providing a link to initiate a communication².

Assuming, *arguendo*, that it would have been obvious to incorporate such a feature into the teachings of the system in the Quick Tour reference, the combination would still fail to teach or suggest certain claim elements. The Examiner does not even allege that the signature block in Email Signature provides an indication of the user's status. Thus, this aspect of the claim is not satisfied. Moreover, the Examiner fails to establish that combination discloses enabling the presentation of at least one user indication within *two or more types* of electronic documents, wherein the electronic documents are capable of being generating using *two or more types of applications*, as recited in independent claim 1.

¹ Applicant believes that it can antedate one or more of the references and reserves the rights to do so should this be necessary. However, given the failure of the Examiner to establish a prima facie case of obviousness, Applicant believes that this is unnecessary at this time and prefers to avoid the unnecessary costs associated therewith.

² It appears that the communication is a chat communication. To the extent this may have

Email Signature appears to describe an email signature that is viewable by two or more email applications. Two different email applications are not different *types of applications*. Rather, they are two instances of the same type of application. Nor are two emails two different *types of documents*. Rather, they are two of the *same type* of documents. An email application, which is one type of application, typically generates one type of electronic document – an email. Thus, the combination fails to satisfy at least these recitations of claim 1.

Independent claims 6, 13, 18, 26-29, and 32-33 each recite patentable features similar to those described above in reference to claim 1. As such, these claims are allowable for at least the reasons provided above. Claims 2-5, 7-12, 14-17, 19-25, 30 and 31 depend from, and add features to, the independent claims. Thus, these claims are allowable at least by virtue of their dependency from allowable claims.

B. Claim 10

In addition to being allowable based on its dependency, claim 10 recites *inter alia* “the step of presenting one or more communication preferences associated with the one or more network users.” The Examiner alleges that ICQ, as described by Quick Tour, enables users to establish communications via one of several possible modes of communication (*e.g.*, e-mail, chat, games, whiteboard, *etc.*). The Examiner characterizes these as “communication preferences.” (*see* Final Office Action, page 6). However, Quick Tour merely discusses the different modes of communication that are possible, but there is no discussion in Quick Tour of presenting a communication preference (*e.g.*, a preferred mode of communication). For at least this reason, the rejection of claim 10 is legally improper and should be overruled.

inadvertently been characterized otherwise earlier in the prosecution, those statements are hereby corrected.

C. **Claim 23**

In addition to being allowable based on its dependency, claim 23 recites *inter alia* “processor readable code that causes the processor to enable the one or more network users to identify a preference for receiving the at least one communication.” The Examiner alleges that ICQ, as described by Quick Tour, enables users to establish communications via one of several possible modes of communication (e.g., e-mail, chat, games, whiteboard, *etc.*). The Examiner characterizes these as “communication preferences.” (*see* Final Office Action, page 6). However, Quick Tour merely discusses the different modes of communication that are possible, but there is no discussion in Quick Tour of enabling a user to identify a preference for receiving communications (e.g., a preferred mode of communication). For at least this reason, the rejection of claim 10 is legally improper and should be overruled.

VIII. **37 C.F.R. §41.37(c)(1)(viii) - CLAIMS APPENDIX**

Appendix A: The pending claims (claims 1-33) are attached in Appendix A.

IX. **37 C.F.R. §41.37(c)(1)(ix) - EVIDENCE APPENDIX**

Appendix B: (None)

X. **37 C.F.R. §41.37(c)(1)(x) - RELATED PROCEEDINGS INDEX**

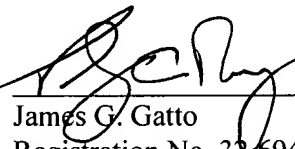
Appendix C: (None)

CONCLUSION

For at least the foregoing reasons, Appellant respectfully requests that the rejection of each of pending claims 1-33 under 35 U.S.C. §103(a) be reversed.

Date: February 28, 2006

Respectfully submitted,

By:  Reg # 55,878
For James G. Gatto
Registration No. 32,694

Customer No. 00909

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, Virginia 22102
Main: 703-770-7900
Fax: 703-905-2500

APPENDIX A

CLAIMS

1. (Previously Presented) A system for presenting a status indicator within two or more types of electronic documents to provide user status associated with one or more network users, the system comprising:

user indicator presentation means for enabling presentation of one or more user indicators within the two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user;

status determining means for determining the status of the one or more network users, wherein the status of the one or more network users is associated with the one or more user indicators; and

status indicator presenting means for presenting at least the status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of applications.

2. (Original) The system of claim 1, wherein the status indicator comprises at least one symbol.

3. (Previously Presented) The system of claim 1, wherein the status indicator presenting means presents the status indicator through use of at least one menu.

4. (Original) The system of claim 1, wherein the status indicator comprises color coding.

5. (Previously Presented) The system of claim 1, wherein the status indicator presenting means indicates the status of the network user by altering representations of the status indicator for the network users.

6. (Previously Presented) A method for presenting a status indicator within two or more types of electronic documents to provide user status associated with one or more network users, the method comprising the steps of:

generating the two or more types of electronic documents using two or more types of applications;

presenting one or more user indicators within the two or more types of electronic documents;

associating each user indicator with at least one network user;

determining a status of the one or more network users associated with the one or more user indicators; and

presenting at least the status indicator and the one or more user indicators, wherein the status indicator indicates the status of network users via the two or more types of applications.

7. (Previously Presented) The method of claim 6, wherein the step of presenting at least the status indicator and the one or more user indicators comprises presenting at least one symbol with the status indicator.

8. (Previously Presented) The method of claim 6, wherein the step of presenting at least the status indicator and the one or more user indicators comprises presenting at least one menu with the status indicator.

9. (Previously Presented) The method of claim 6, wherein the step of presenting at least the status indicator comprises color coding.

10. (Previously Presented) The method of claim 6, further comprising the step of presenting one or more communication preferences associated with the one or more network users.

11. (Previously Presented) The method of claim 10, further comprising the step of establishing one or more communications with the one or more network users.

12. (Previously Presented) The method of claim 6, further comprising the step of enabling at least one application to be shared among the one or more network users.

13. (Previously Presented) A system for presenting a status indicator within two or more types of electronic documents to provide user status associated with one or more network users, the system comprising:

a user indicator presentation module that presents one or more user indicators within the two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user;

a status determining module that determines a status of the one or more network users associated with the one or more user indicators; and

a status indicator presenting module that presents at least the status indicator and the user indicators within the two or more types of electronic documents to provide the status of network users via the two or more types of applications.

14. (Original) The system of claim 13, wherein the status indicator comprises at least one symbol.

15. (Previously Presented) The system of claim 13, wherein the status indicator presenting module presents the status indicator using at least one menu.

16. (Original) The system of claim 13, wherein the status indicator comprises color coding.

17. (Previously Presented) The system of claim 13, wherein the status indicator presenting module is adapted to indicate the status of network users by altering representations of the status indicator for the network users.

18. (Previously Presented) A processor readable medium having processor readable code embodied therein for presenting a status indicator within two or more types of electronic documents to provide user status for one or more network users, the medium comprising:

processor readable code that causes a processor to enable the one or more network users to generate the two or more types of electronic documents using two or more types of applications;

processor readable code that causes the processor to present one or more user indicators within the two or more types of electronic documents, each user indicator being associated with the one or more network users;

processor readable code that causes the processor to determine the status of one or more network users associated with the one or more user indicators; and

processor readable code that causes the processor to present at least the status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of applications.

19. (Original) The medium of claim 18, wherein the status indicator comprises at least one symbol.

20. (Previously Presented) The medium of claim 18, wherein the processor readable code causes the processor to present the status indicator using at least one menu.

21. (Previously Presented) The medium of claim 18, wherein the processor readable code causes the processor to present the status indicator using color coding.

22. (Previously Presented) The medium of claim 21, further comprising processor readable code that causes the processor to establish at least one communication with the one or more network users.

23. (Previously Presented) The medium of claim 22, further comprising processor readable code that causes the processor to enable the one or more network users to identify a preference for receiving the at least one communication.

24. (Previously Presented) The medium of claim 18, further comprising processor readable code that causes the processor to enable the one or more network users to establish conference communications.

25. (Previously Presented) The medium of claim 24, wherein the processor readable code causes the processor to enable the one or more network users to share at least one application.

26. (Previously Presented) A system for presenting a status indicator within two or more types of electronic documents to provide user status associated with one or more network users, the system comprising:

a user indicator presentation module that presents one or more user indicators within the two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user;

a status determining module associated with a first system application that determines a status of the at least one network user associated with the one or more user indicators; and

a status indicator presenting module associated with a second system application that presents at least the status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of applications, wherein the first system application and the second system application are different system applications.

27. (Previously Presented) A system for presenting a status indicator within two or more types of electronic documents to provide user status associated with at least one network user, the system comprising:

a user indicator presentation module that presents one or more user indicators within the two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of non-HTML applications and wherein each user indicator is associated with the at least one network user;

a status determining module that determines a status of the at least one network user associated with the one or more user indicators; and

a status indicator presenting module that presents at least the status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of non-HTML applications.

28. (Previously Presented) A communication system comprising:

a user indicator presentation module that presents one or more user indicators within two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications, wherein each user indicator is associated with at least one network user, and wherein the at least one network user comprises all network users capable of accessing the communication system;

a status determining module associated with a first system application that determines a status of the at least one network user associated with the one or more user indicators; and

a status indicator presenting module associated with a second system application that presents at least a status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of applications, wherein the first system application and the second system application are different system applications.

29. (Previously Presented) A communication system comprising:

a user indicator presentation module that presents one or more user indicators within two or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications, wherein each user indicator is associated with at least one network user, and wherein the at least one network user comprises all network users capable of accessing the communication system;

a status determining module that determines a status of the at least one network user associated with the one or more user indicators; and

a status indicator presenting module that presents at least a status indicator and the user indicators in the two or more types of electronic documents to provide the status of network users via the two or more types of applications.

30. (Previously Presented) The system of claim 1, wherein the two or more types of electronic documents include at least one of an electronic mail message, a Hypertext Markup Language document, and a word processing document.

31. (Previously Presented) The system of claim 13, wherein the two or more types of electronic documents include at least one of an electronic mail message, a Hypertext Markup Language document, and a word processing document.

32. (Previously Presented) A system for presenting status indicators within two or more types of electronic documents that are generated using two or more types of applications to provide user statuses associated with a plurality of network users, the system comprising:

a user directory that includes user information that corresponds to the plurality of network users, wherein the user information includes user indicators;

documents generated by the two or more applications, wherein each document includes at least two user depictions associated with at least two network users;

an identification determining module that references the user directory to access at least two user indicators that correspond to the at least two network users associated with the at least two user depictions included in the documents;

a user indicator presentation module that presents the at least two user indicators within the documents, wherein the user indicator presentation module is capable of presenting the at least two user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications;

a status determining module that determines statuses of the at least two network users; and

a status indicator presenting module that presents at least two status indicators within the documents to provide the statuses of the at least two network users, the at least two status indicators being associated with the at least two user indicators.

33. (Previously Presented) A system for presenting status indicators to provide user statuses associated with two or more network users within two or more types of electronic documents that are generated using two or more types of applications, the system comprising:

documents generated by the two or more types of applications, wherein each of the documents includes a plurality of document fields;

a user indicator presentation module that presents a plurality of user indicators, the plurality of user indicators being presented within two or more of the plurality of document fields and being associated with two or more network users, wherein the user indicator presentation module is capable of presenting the plurality of user indicators within the two or more types of electronic documents that are capable of being generated using the two or more types of applications;

a status determining module that determines statuses of the two or more network users; and

a status indicator presenting module that presents a plurality of status indicators within the documents to provide the statuses of the two or more network users, the plurality of status indicators being associated with the plurality of user indicators and being presented within the two or more of the plurality of fields of the documents.

APPENDIX B

EVIDENCE APPENDIX

NONE

APPENDIX C

RELATED PROCEEDINGS INDEX

NONE